

REMARKS

Claims 2, 5, 11, 15-16, 18-19, 31, 34-35, 56-57, and 59 are pending in this application. Claims 7, 31, 34, 35, and 58 have been rejected. Claims 1, 3-4, 6-10, 12-14, 17, 20-30, 32-33, 36-55, 58, and 60-125 have been cancelled without prejudice. Claims 2, 5, 11, 15-16, 18-19, 56-57, and 59 have been allowed.

Claims 2, 5, 18, and 19 have been amended for clarification. Claims 31, 34, and 35 have been amended to address the Examiner's concerns.

Each claim amendment is supported by the specification as originally filed. No new matter has been added to the present application.

Applicants wish to thank the Examiner for taking the time to review and consider proposed claim amendments with respect to claims 31, 34, and 35 and the enablement rejection thereto.

Specification

The Examiner has maintained the new matter rejection to the specification because of the reference to an incorporation by reference of U.S. Serial No. 09/881,797 (the "797 application"), and further contends that "[a]s the priority claim submitted in the transmittal letter did not incorporate the disclosure of the '797 application by reference, any information incorporated by reference in the 21 September amendment that is not already present in the instant disclosure as filed constitutes new matter" (Office Action- page 3). Applicants respectfully disagree.

Enclosed is a copy of the Utility Transmittal as filed on October 22, 2001 and stamped received return postcard confirming acceptance of all of the parts of the application, including the Utility transmittal. The transmittal clearly indicates that prior applications, including the parent application of U.S. Application Serial No. 09/881,797, filed June 14, 2001 (see, Transmittal- page 3; top and bottom), and the provisional application of U.S. Application Serial Number 60/211,749, filed June 14, 2000 (see, Transmittal- page 2; bottom), are incorporated by reference in their entirety.

For the above reasons, applicants assert that no new matter has been introduced by the amendments presented in the April 20, 2006 response. Reconsideration and withdrawal of this objection to the specification regarding new matter are respectfully requested.

35 U.S.C. §112, first paragraph Rejections

Claims 7 and 58 stand rejected under 35 U.S.C. §112, first paragraph, because the Examiner alleges that the specification does not enable one skilled in the art to use the invention commensurate in scope with the claims. Applicants respectfully traverse the Examiner's contention. However, in order to expedite prosecution and allowance of the instant application, applicants have cancelled claims 7 and 58, thereby rendering the §112, first paragraph rejection moot. Applicants respectfully request reconsideration and withdrawal of the §112, first paragraph rejection of claims 7 and 58.

Claims 31, 34, and 35 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement rejection for the phrase "pharmaceutical composition." Applicants respectfully disagree. However, in order to expedite prosecution and allowance of

the instant application, applicants have amended the claims to delete the term “pharmaceutical.” Support for the claimed composition may be found throughout the instant specification, for example, at page 87 under “Therapeutics.” No new matter has been introduced by the deletion of the term, “pharmaceutical.” In view of the Examiner’s belief that these amendments would overcome the enablement rejection, applicants respectfully request reconsideration and withdrawal of the §112, first paragraph rejections.

Response to 35 U.S.C. §112, second paragraph Rejections

Applicants thank the Examiner for the withdrawal of the rejection of claim 34 based on 35 U.S.C. §112, second paragraph.

Response to 35 U.S.C. §102(e) Rejections

Applicants thank the Examiner for the withdrawal of the rejection of Claims 2, 5, 7, 11, 15-16, 18-19, and 56-59 based on 35 U.S.C. §102(b) as anticipated by Buell et al.

Response to 35 U.S.C. §103 Rejections

Applicants thank the Examiner for the withdrawal of the rejection of claims 2, 5, 11, 15, 31, 34, and 35 based on §103 as obvious in view of Buell, et al. and Maniatis, et al.

CONCLUSION

Based on the foregoing amendments and remarks, applicants believe that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection of claims and allowance of this application are respectfully requested.

AUTHORIZATION

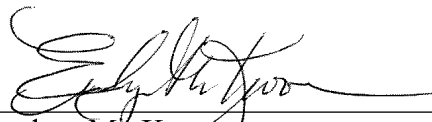
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 2976-4044US1.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2976-4044US1.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: November 20, 2006

By: _____




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Case No. 2976-4044US1 Serial No. To Be Assigned
Date Mailed October 22, 2001 ATTY C. DeHoratius
Date Due in the Patent Office _____

The return of this post card, properly stamped, will
acknowledge receipt in the Patent & Trademark Office
of the following:

1. Utility Patent Application containing 364 total pages, including 241 pages of Specification, 18 pages of Claims, 1 page of Abstract; 104 sheets of Drawings (Figures 1A-1D; 2A-2P; 3A-3G; 4; 5A-5I; 6A-6U; 7A-7H; 8; 9A-9F; 10-26; 27A-27K; and 28A-28C);
2. Sequence Listing (3 CD-ROMs);
3. Statement for CD-ROM Submission of Seq. List., 2 pages;
4. Declaration and Power of Attorney, 8 pages;
5. Utility Patent Transmittal, 4 pages;
6. Filing Fee (check for \$3788.00);
7. Request and Certification for Non-Publication of Utility App., 1 page;
8. Copy of Notification of Withdrawal of International App., 1 page;
9. Express Mail Certif., 1 page; **EXPRESS MAIL NO. EL 912 004 429 US**

jc826 U.S. PTO
10/021698

10/22/01

Docket No. 2976-4044US1

Express Mail No. EL 912 004 429 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

UTILITY APPLICATION AND FEE TRANSMITTAL §(1.53(b))

Commissioner for Patents

Box Patent Application

Washington, D.C. 20231

Sir:

Transmitted herewith for filing is the patent application of

Inventor(s) names and addresses

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For: NUCLEOTIDE AND AMINO ACID SEQUENCES RELATING TO RESPIRATORY DISEASES AND OBESITY

Enclosed Are:

241 page(s) of specification

1 page(s) of Abstract

18 page(s) of claims

104 sheets of ☐ Formal ☒ Informal drawings

8 page(s) of Declaration and Power of Attorney

☒ Unsigned

☐ Newly Executed

☐ Copy from prior application

☐ Deletion of inventors including Signed Statement under 37 C.F.R. §1.63(d)(2)



REQUEST FOR NON-PUBLICATION OF APPLICATION ATTACHED

- ☒ Incorporation by Reference:
 - ☒ The entire disclosure of the prior application is considered as being part of the disclosure of the accompanying application and is incorporated herein by reference.
- ☐ Deletion of Inventors (37 C.F.R. §1.63(d) and §1.33(b))
- ☐ Signed statement attached deleting inventor(s) named in the prior application serial no. _____, filed _____.
- ☐ Microfiche Computer Program (Appendix)
- ☒ Computer readable disks containing Sequence Listing (3 CD-ROMs)
- ☒ Statement to Accompany CD-ROM submission of Sequence Listing
- ☐ Assignment Papers (assignment cover sheet and assignment documents)
 - ☐ A check in the amount of \$40.00 for recording the Assignment
 - ☐ Charge Assignment Fee to Deposit Account No. 13-4500, Order No.
 - ☐ Assignment Papers filed in the parent application Serial No.
- ☐ Certification of chain of title pursuant to 37 C.F.R. §3.73(b)
- ☐ Priority is claimed under 35 U.S.C. §119 for:
Application No(s). _____, filed _____, in _____ (country).
 - ☐ Certified Copy of Priority Document(s) [_____]
 - ☐ filed herewith
 - ☐ filed in application Serial No. _____, filed _____.
 - ☐ English translation document(s) [_____]
 - ☐ filed herewith
 - ☐ filed in application Serial No. _____, filed _____.
- ☒ Priority is claimed under 35 U.S.C. §119(e) for:
Provisional Application No. 60/211,749, filed June 14, 2000.
- ☐ Information Disclosure Statement
 - ☐ Copy of [_____] cited references
 - ☐ PTO Form-1449
 - ☐ References cited in parent application Serial No. _____, filed _____.
- ☐ Related Case Statement under 37 C.F.R. §1.98(a)(2)(iii)
 - ☐ A copy of related pending U.S. Application(s) Serial No(s): _____, filed _____, respectively, is attached hereto.
 - ☐ A copy of related pending U.S. Application(s) entitled, _____, filed _____ to inventor(s) _____, respectively, is attached hereto.
 - ☐ A copy of each related application(s) was submitted in parent application serial no. _____, filed _____.


- ☐ Preliminary Amendment
- ☒ Return receipt postcard (MPEP 503)
- ☒ This is a ☒ continuation ☐ divisional ☐ continuation-in-part of prior application serial no. 09/881,797, filed June 14, 2001, to which priority under 35 U.S.C. §120 is claimed.
- ☐ Cancel in this application original claims _____ of the parent application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☐ A Preliminary Amendment is enclosed. (Claims added by this Amendment have been properly numbered consecutively beginning with the number following the highest numbered original claim in the prior application).
- ☒ The status of the parent application is as follows:
- ☐ A Petition for Extension of Time and a Fee therefor has been or is being filed in the parent application to extend the term for action in the parent application until _____.
- ☐ A copy of the Petition for Extension of Time in the co-pending parent application is attached.
- ☒ No Petition for Extension of Time and Fee therefor are necessary in the co-pending parent application.
- ☒ Please abandon the parent application at a time while the parent application is pending or at a time when the petition for extension of time in that application is granted and while this application is pending has been granted a filing date, so as to make this application co-pending.
- ☐ Transfer the drawing(s) from the parent application to this application
- ☒ Amend the specification by inserting before the first line the sentence: This is a ☒ continuation ☐ divisional ☐ continuation-in-part of co-pending application Serial No. 09/881,797, filed June 14, 2001, and a ☐ continuation ☐ divisional ☒ continuation-in-part of application Serial No. 60/211,749, filed June 14, 2000.

I. CALCULATION OF APPLICATION FEE				
	Number Filed	Number Extra	Rate	Basic Fee \$710.00/355.00
Total Claims	111 - 20 =	91 x	\$18.00/ \$9.00	\$ 1638.00
Independent Claims	21 - 3 =	18 x	\$80.00/ \$40.00	\$ 1440.00
<input type="checkbox"/> Multiple Dependent Claims		If marked, add fee of \$270.00 (\$135.00)		\$ 0.00
TOTAL:				\$ 3788.00

- ☐ Small entity status is or has been claimed. Reduced fees under 37 C.F.R. §1.9 (f) paid herewith \$_____.
- ☒ A check in the amount of \$3788.00 in payment of the application filing fees is attached.
- ☐ Charge fee to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for filing this application pursuant to 37 CFR §1.16, **including all extension of time fees pursuant to 37 C.F.R. § 1.17 for maintaining copendency** with the parent application, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2976-4044US1. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
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Dated: October 22, 2001

By: 
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